

DETAILED ACTION

Response to Amendment

This office action is in response to Request for Continued Examination filed March 31, 2008. Applicant canceled claims 3-8 and added new claims 9-14. Claims 2 and 9-14 are currently pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 which depends on claim 2 recites “the method of claim 2 further comprising *entering an offer* in which one of said target audience characteristics is that recipients of said amount of money must, after exposure to said message, purchase a specified product or service within a specified period of time”. Since applicant is claiming “entering an offer” it is unclear if this offer is different from the advertiser’s offer provided in claim 2. It is unclear if the user is provided one offer to pay attention to a specific message and another offer to purchase a specific product or service, after he/she is exposed to the specific message. Clarification is respectfully requested.

Claims 10-14 also have similar issue since the claims recite “entering an offer” and it is not clear if the offer is in addition to the offer provided in claim 2 and/or 9 or is the same offer claimed in claim 2 or/and 9. Clarification is respectfully requested.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz 6,298,330 in view of Goldhaber U.S. No. 5,855,008, in view of Walker et al. U.S. Patent No. 6,086,477 and further in view of Vance U.S. Patent No. 6,267,672.

Regarding claim 2, Gardenswartz teaches (a) entering into the computer an advertiser offer that said recipients will be owed an amount of money if they pay attention to a specified ad message, and if they satisfy a set of at least one target audience characteristics (the value contract is a promotional incentive in which the consumer is offered a reward for complying with a particular behavioral pattern such as a predefined change in behavior or the continuance of an established behavior); (b) stating said characteristics as a set of offer conditions by said advertiser, (c) specifying said amount of money as an expected value (EV), said EV to be paid via an EV payment bet including a Payoff, (d) presenting an interface to the public for enabling anyone to access and accept said offer, (e) registering acceptance of said offer by a user called a recipient, said acceptance entailing: registering the recipient's identity (see col. 14 line 54 to col. 15 line 45). Gardenswartz teaches the consumer being offered a reward for complying with a particular behavioral pattern but does not explicitly teach the value contract is rewarded if they pay attention to an ad message and also purchase the product. Goldhaber teaches entering into the computer an advertiser offer that said recipients will be owed an amount of money if they

Art Unit: 3622

pay attention to a specified ad message (see col. 7. lines 23-67, col. 11 line 49 to col. 12 line 45 and col. 14 line 65 to col. 17 line 25). Gardenswartz teaches in order for a consumer to fulfill a value contract and receive a reward, the consumer may be required to purchase a pre-selected amount of a specified product within a predetermined amount of time. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to know that the consumer of Gardenswartz would view the ad message of the product that they are required to purchase. Thus, one of ordinary skill in the art would expect the consumers to pay attention to the product, as in Goldhaber, before they purchase the product and receive the offer, as in Gardenswartz.

Walker teaches paying expected value including a payoff to players (see col. 9 line 1 to col. 10 line 48). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Gardenswartz's reward for purchasing product and Walker lottery system, since randomly selecting winners and paying expected value of the award to selected ones reduce the outcome of bets or winners. Therefore, one would be motivated to provide chance of winning to all participants and paying Expected value to only selected winner in order to reduce the outcome. Both Gardenswartz/Goldhaber/Walker failed to teach inspecting winners, if they satisfy offer condition, it is taught in Vance. Vance teaches winners submit information prior to receiving the prize (see col. 6 lines 34-54). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Gardenswartz's value contract offer and Walker's payment of expected value and Vance verification of winners, in order to prevent dishonest consumers from fraudulently claiming prizes, as taught by Vance (see col. 6 lines 34-54).

Regarding claims 9-13, Gardenswartz teaches entering an offer in which one of said target audience characteristics is that recipients of said amount of money must, after exposure to said message, purchase a specified product or service within a specified period of time, *said purchase not necessarily being from said advertiser*; said amount of money paid to recipients varies depending on the amount of said purchase; one of said target audience characteristics is that recipients make said purchase at a specified location; recipients make said purchase with a specified payment vehicle; who the recipients make said purchase from (col. 15 line 9 to col. 16 line 41).

Regarding claim 14, Gardenswartz does not teach entering an offer in which one of said target audience characteristics is that said recipient is the purchasing decision-maker for a specified organization. However official notice is taken that is old and well known for retailer to provide reward to decision-maker of companies for procuring product for the company or organization. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for Gardenswartz to provide the value contract offer to company buyers to maximize the profit.

Response to Arguments

Applicant's arguments filed March 31, 2008 have been fully considered but they are not persuasive. Applicant's argument is that the claimed invention does not use profiles and eliminates the need for profiles. Applicant further asserts that while it is true that the invention can be used in conjunction with certain profile data, the claimed invention does not employ profiles, beyond using identity data. Applicant argues that while Gardenswartz teaches giving consumers value contracts in exchange for complying with "*a particular behavior pattern*", this

requires, and Gardenswartz describes, the collecting and maintaining of those patterns.

Applicant's claimed invention has no need for such pattern collection, and does not enable payment based on "established behavior patterns", therefore, applicant respectively submits that the prior art should not be applied against the invention of claim 2. Applicant also argues that unlike Goldhaber and Gardenswartz, the claimed invention enables anyone to be exposed to a message and a recipient's qualifications are probabilistically inspected AFTER the recipient has been exposed to a commercial message. The claimed invention lets users agree to receive messages and accept payment with no profiles necessary.

Gardenswartz teaches registering the consumers (any consumer to be exposed to a message) and providing a value contract in which the consumer is offered a reward for complying with a particular behavioral pattern such as a predefined change in behavior or the continuance of the established behavior as determined from the consumer purchase histories. Gardenswartz further teaches that customized Web pages full of coupons and customized according to the consumer's observed purchase history (profile). According to Gardenswartz the profile is used to select what type of message to display, not to exclude user from registering. Therefore, even in Gardenswartz the invention lets users to agree to receive messages and to accept payment. Examiner would like to point out that applicant's invention would work the same or provide the same result whether the specific message is selected based on the user profile or not, i.e. the user would still be paid the specified EV payment in exchange for the attention to any message selected by the advertiser. Examiner would also like to point out that it is also well settled that the elimination of an element or its functions is an obvious expedient if

Art Unit: 3622

the remaining elements perform the same functions as before - *In re Karlson*, 136 USPQ 184, 186; 311 F.2d 581 (CCPA 1963).

Applicant also argues that if Goldhaber were to add the methods of the claimed invention, Goldhaber would have no need for one of its self-described "basic principles of operation," that is, privacy implemented via channeling ads according to protected profiles. And, if Gardenswartz were to add the methods of the claimed invention, Gardenswartz would have no need of its core principle of operation, which is utilizing a purchase history or behavioral pattern to channel ads or offers. In response to applicant's argument, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Regarding claim 9 applicant asserts that the claim now include a clause "*said purchase not necessarily being from said advertiser*". Applicant provides example that Microsoft might pay a consumer to read an article about the Windows operating system provided that the consumer subsequently buys an Apple operating system. Examiner would like to point out that according to claim 9, the consumer is not required to buy a product of a competitor to get the offer. The claim just indicates that the purchase does not have to be from the advertiser which is understood to mean that it could be from the advertiser but not necessarily. It could also mean that an advertiser could be a promoter of different products from different manufacturers or suppliers which means that the advertiser does not own any of the products.

Applicant also argues that Gardenswartz does not enable payment to consumer for their attention to message. According to Applicant's invention the user is not paid for the attention only. The user is required to pay attention to a message and then purchase a product within a specified period to get the offer. Goldhaber teaches user getting paid for paying attention to message, but since applicant also requires user to buy a product after paying attention to message Gardenswartz was applied since Gardenswartz teaches providing a reward for changing behavioral pattern such as buying a specific product within a predetermined amount of time. Examiner would like to point out again that the user in order to purchase the product within a predetermined amount of time would pay attention to the product since a user have to look at the product and make a decision whether to buy the product or not. Goldhaber was applied to show the feature of user's getting paid for their attention, without the need to purchase a product.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

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/Yehdega Retta/

Primary Examiner, Art Unit 3622